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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,089	09/10/2003	Anthony S. Salemi	MEG-P-03-001	2725
29013	7590	04/19/2010	EXAMINER	
PATENTS+TMS, P.C. 2849 W. ARMITAGE AVE. CHICAGO, IL 60647			CORDRAY, DENNIS R	
			ART UNIT	PAPER NUMBER
			1791	
			MAIL DATE	DELIVERY MODE
			04/19/2010	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY S. SALEMI,
DANIEL J. MULVEY, and ANTHONY C. PAPPAGEORGE

Appeal 2009-003779
Application 10/659,089
Technology Center 1700

Decided:

Before CHARLES F. WARREN, PETER F. KRATZ, and
MARK NAGUMO, *Administrative Patent Judges*.

NAGUMO, *Administrative Patent Judge*.

DECISION ON APPEAL

A. Introduction¹

Anthony S. Salemi, Daniel J. Mulvey, and Anthony C. Pappageorge (“Salemi”) timely appeal under 35 U.S.C. § 134(a) from the final rejection² of claims 30-51 and 53-55, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6. We AFFIRM.

The subject matter on appeal relates to: (a) processes of making “papers” comprising one or more water resistant layers and antimicrobial layers (a polyethylene having silver zeolite), laminated to a “sheet” of unspecified composition (independent claims 30-34, and 44); (b) to a “paper” (independent claim 35) having a “base” of unspecified composition to which are laminated one or more water resistant and antimicrobial layers; and (c) to the use of such a paper (independent claim 51, which recites that the sheet is made of paper). In certain embodiments (e.g., independent process claims 33, 34, dependent claim 48; dependent paper claims 37, 38, 40-42), a paper layer is connected to the sheet or base. The various claims recite various orderings of the recited layers. The papers are indented to provide a texture that, for example, resists slippage, cushions for cutting, or prevents liquid pooling. The papers are said to be useful for protecting objects from biological contamination, e.g., on a wet countertop.

¹ Application 10/659,089, *Indented Antimicrobial Paper and a Process for Making and Using the Same*, filed 10 September 2003. The specification is referred to as the “089 Specification,” and is cited as “Spec.” The real party in interest is listed as MicrobeGuard Corp. (Appeal Brief, filed 17 March 2008 (“Br.”), 1.)

² Office action mailed 26 October 2007 (“Final Rejection”; cited as “FR”).

Representative Claim 30 is reproduced from the Claims Appendix to the Principal Brief on Appeal:

30. A process for making a paper, the process comprising the steps of:

providing a sheet having a first side and a second side
wherein the second side is in a position opposite to the first side
wherein the sheet is substantially flat and forms a plane;
connecting a water resistant layer to the first side of the sheet;
scoring the water resistant layer;
connecting a first antimicrobial layer to the water resistant layer
wherein the water resistant layer is located between the antimicrobial layer and the sheet
wherein the first antimicrobial layer is made from polyethylene having silver zeolite;
connecting a second antimicrobial layer to the second side of the sheet wherein
the second antimicrobial layer is made from polyethylene having silver zeolite; and
providing a plurality of depressions uniformly spaced across the first side of the sheet.

(Br., Claims App., 1; paragraphing and indentation added.)

The Examiner has maintained the following grounds of rejection:³

- A. Claims 30-48 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Santelli,⁴ Trogolo,⁵ Nakamura,⁶ and Otten.⁷

³ Examiner's Answer mailed 4 June 2008. ("Ans."). All rejections based on 35 U.S.C. §§ 112(1) and (2) have been withdrawn. (Ans. 7.)

B. Claims 49-51 and 53-55 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Santelli, Trogolo, Nakamura, Otten, and Weder.⁸

The Examiner relies on Santelli for teachings of a general paper laminated to a plastic film having a biocide associated with the laminate; on Trogolo for teachings of antibiotic linear low density polyethylene films containing silver zeolite as a coating for various substrates [including medical articles, paper, etc.] and, essentially cumulatively, on Nakamura (which describes an antimicrobial polyethylene silver zeolite sheet as a lining for the inner surface of a bottle cap); and on Otten, for teachings of grooved or channeled multiple layer absorbent, cut-resistant sheets with an antibacterial agent cover layer and liquid impervious backing layer. The Examiner acknowledges that the order of laminating is not described by Santelli (FR 9; Ans. 9-10), but argues that a number of laminate orders are specifically described (including paper-plastic, paper-plastic-paper, paper-plastic-plastic-paper, paper plastic-paper-plastic), and that varying the order

⁴ Thomas Robert Santelli, *Biocide Containing Laminate as Tape or Packaging Material*, U.S. Patent Application Publication US 2004/0071902 A1, 15 April 2004, based on an application filed 1 October 2002.

⁵ Jeffrey A. Trogolo and John E. Barry, *Antibiotic Hydrophilic Polymer Coating*, U.S. Patent 6,436,422 B1 (20 August 2002).

⁶ Kenji Nakamura, *Container Assembly Provided With Antibacterial Agent Against Slow-Leak Bacteria*, U.S. Patent 6,179,141 B1 (2001).

⁷ Geneva Gail Otten et al., *Absorbent Sheet Material Having Cut-Resistant Layer and Method for Making the Same*, U.S. Patent 6,274,232 B1 (2001).

⁸ Donald E. Weder, *Method of Using a Floral Wrapper Utilizing a Breathable Packaging Material*, U.S. Patent 5,921,062 (1999).

of layers would have been obvious, absent evidence of new or unexpected results. (FR 9; Ans. 10.) As for the use of polyethylene containing silver zeolite as the antimicrobial layer, the Examiner argues that it would have been obvious to use the layers as taught by Trogolo or Nakamura; and that indentation or grooves would have been obvious to allow for drainage of liquids or to facilitate disposal, as taught by Otten (FR 10-11; Ans. 11-12). Similarly, the Examiner relies on Weder for the disclosure of shredding an antimicrobial paper (claim 49), for dividing a paper into plural sheets (claim 50), and for various ways of protecting an object against contamination by placing the object on the sheet, wrapping, or enclosing the object by the sheet (claims 51 and 53-55). (FR 12-14; Ans. 12-14.)

Salemi argues that the references do not, individually or in combination, teach or suggest the subject matter recited in each of the independent claims. More particularly, with respect to claims 30 and 31, Salemi argues that none of the references “discloses a plastic-paper-plastic-plastic laminate.” (Br. 26, ll. 3-4, 14-15; 26, l. 24 to 27, l. 1; 33, ll. 6-7; Reply⁹ 5, ll. 7-8.) Although each argument for patentability of the independent claims is presented in a separate paragraph, the arguments amount to a recitation of the limitations of each claim and a denial that the limitations are taught or suggested. Similarly, Salemi denies that there would have been any reason or suggestion to combine the references. (Br. 31.) In Salemi’s words, even if “all elements perform their ordained and expected functions,” “[t]he test [for obviousness] is whether the invention as a whole, in light of the teachings of the references in their

⁹ Reply Brief, filed 7 August 2008. (“Reply”).

entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made.” (Br. para. bridging 30-31.) Salemi does not, however, identify specific findings of the Examiner regarding the references as error; nor does Salemi explain why specific reasons offered by the Examiner for combining the references are incorrect or improper. Finally, Salemi does not, in its Principal Brief on Appeal, argue patentability based on unexpected results or other “secondary considerations.”

B. Discussion

Findings of fact throughout this Opinion are supported by a preponderance of the evidence of record.

As the Appellant, Salemi bears the procedural burden of showing harmful error in the Examiner’s rejections. *See, e.g., Shinseki v. Sanders*, 129 S.Ct. 1696, 1706 (2009) (citations omitted) (“Lower court cases make clear that courts have correlated review of ordinary administrative proceedings to appellate review of civil cases in this respect. . . . [T]he party seeking reversal normally must explain why the erroneous ruling caused harm.”) *See also, In re Chapman*, 595 F.3d 1330, 1338 (Fed. Cir. 2010) (discussing the role of harmless error in appeals from decisions of the Board of Patent Appeals and Interferences (“Board”)). Arguments not timely made have been waived. 37 C.F.R. § 41.37(c)(1)(vii) (second sentence); *see also In re Hyatt*, 211 F.3d 1367, 1373 (Fed. Cir. 2000) (an argument not first raised in the brief to the Board is waived on appeal).

To rebut a *prima facie* case of obviousness, it is not enough for an appellant to simply agree with the Examiner that no single reference teaches

all the required limitations, and to deny that the combinations of teachings are inadequate. Such an “argument” amounts to an invitation to the Board to make findings in the first instance regarding the teachings of the references, to weigh those findings against the findings of the Examiner, and to decide all further factual inferences and legal conclusions in favor of the appellant. We decline to accept such invitations, as our role is review of the arguments of record, not independent examination of the claimed invention.

In the present case, the Examiner has acknowledged the differences between the teachings of the individual references and the claimed processes of making laminated papers, laminated papers, and processes of using the laminated papers. (FR 8-9.) The Examiner has also offered an explanation of why connecting the various different layers to one another in different orders than the orders expressly disclosed by Santelli would have been obvious. (*Id.*) While we do not find the caselaw cited by the Examiner to be directly on point,¹⁰ the underlying rationale that undergirds the rejection is reasonably understandable and persuasive. That is, the prior art of record indicates that persons having ordinary skill in the art understood the functions of absorptive paper layers, water resistive layers, and antimicrobial layers, and the level of ordinary creativity and skill was such that they could and did vary the order of layers to obtain laminated papers having expected properties. Thus, the claimed invention involves a highly predictable art and purposeful, sophisticated artisans. Under such circumstances, the Supreme

¹⁰ The processes at issue in *Ex parte Rubin*, 128 USPQ 440 (BPA 1959) and in *In re Burhans*, 154 F.2d 690 (CCPA 1946), appear to lead to identical products, whereas the products are distinct in Salami’s appealed claims.

Court explained recently, “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). In the present appeal, however, Salemi has not come forward with evidence of unexpected results or of other so-called “secondary considerations” indicative of nonobviousness of providing different orders of layers known to be used in laminated paper sheets.

As for the combinations of teachings, using a known material for its known function to perform that same function is a classical instance of obviousness. Salemi has not come forward with any credible evidence, nor has Salemi offered any credible argument, explaining why it would not have been obvious to use the polyethylene films containing silver zeolite described by Trogolo or Nakamura as layers in the antimicrobial paper laminates described by Santelli. Nor has Salemi come forward with credible evidence or argument indicating why providing grooves, as taught by Otten, or shredding the laminated papers, or wrapping objects with the papers to protect them from contamination, as taught by Weder, would have been beyond the level of ordinary skill in the art to apply to other laminated papers.

We conclude that Salemi has failed to carry its burden of proving harmful error in the Examiner's rejections.

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D. Order

We AFFIRM the rejection of claims 30-48 under 35 U.S.C. § 103(a) in view of the combined teachings of Santelli, Trogolo, Nakamura, and Otten.

We AFFIRM the rejection of claims 49-51 and 53-55 under 35 U.S.C. § 103(a) in view of the combined teachings of Santelli, Trogolo, Nakamura, Otten, and Weder.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Ssl

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